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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,805	12/18/2001	Tetsuo Oyama	MTS-3299US	5979

7590 10/03/2007  
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EXAMINER
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BILGRAMI, ASGHAR H

ART UNIT	PAPER NUMBER
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2143

MAIL DATE	DELIVERY MODE
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10/03/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/025,805

Applicant(s)

OYAMA, TETSUO

Examiner

Asghar Bilgrami

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 6-12 and 15-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 1-3, 6-12 and 15-31 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claims 1, 10, 19, 20, 21, 22, 23, 24 & 25 are again rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Amendment of Claim 1 on line 12 states "wherein said second provider server transfers at least one email that is sent to said second e-mail address". However in the preceding limitation states "wherein said first provider server transfers an e-mail that is sent to said first mail address to said second provider server upon receiving this e-mail". The claim language is ambiguous and unclear since it suggests sending e-mail to the second provider server **not** the second e-mail address hence making the claim language indefinite. Additionally on line 16 the amended claim language states "and wherein until the e-mail address set in the first provider server is invalid as said client's address....". However line 5 of the claim states "a first provider server in which a first e-mail address of a client is maintained as valid in the server as set". These are two contradictory statements making the claim language indefinite.
- Since the initial limitations of the independent claims are ambiguous, confusing and contradictory the later limitations cannot be interpreted in a clear manner as to what they are relating to.

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Claims 10, 19, 20, 21, 22, 23, 24 & 25 contain similar indefinite language and are also rejected.

**3. Applicant's representative is again advised to formulate the claim language in such a way that portrays the applicant's invention in a simple and clear manner to further advance the prosecution of this application.**

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 1-3, 6-12, 15-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly (U.S. 6,427,164 B1) and Nielson (U.S. 6,405,234 B1).

6. As per claims 1, 10, 21, 19, 20, 22, 23, 24, 25, 26, 27 & 28 Reilly disclosed an address change notification deputization service server that provides notification about a client's e-mail address change to a sender of an e-mail after the sender sends an e-mail to a client, the server comprising, wherein when a first provider server in which a

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first mail address of a client is maintained as valid in the server as set receives an e-mail that is sent to said first mail address this e-mail is transferred to a second provider server in which a second mail address of said client is maintained as valid in the server as set and, then, when said second provider server receives an e-mail transferred from said first provider server (Reilly, col.4, lines 44-62). However Reilly did not explicitly disclose that said address change notification deputization service server receives this transfer, and wherein until the e-mail address is set in the first provider server is invalid as said client's address, whether the e-mail is sent through the first provider server is checked, based on the path taken by the e-mail through the sender's e-mail server, if the e-mail is sent through the first provider server, said address change notification deputization service server makes a notification to the sender of this e-mail to the effect that the e-mail address of said client is said second mail address to the sender of this e-mail.

In the same field of endeavor Nielson disclosed that said address change notification deputization service server receives this transfer, and wherein until the e-mail address is set in the first provider server is invalid as said client's address, whether the e-mail is sent through the first provider server is checked, based on the path taken by the e-mail through the sender's e-mail server, if the e-mail is sent through the first provider server, said address change notification deputization service server makes a notification to the sender of this e-mail to the effect that the e-mail address of said client is said second mail address to the sender of this e-mail (Nielsen, col.2, lines 58-67, Col.6, lines 11-67 & col.7, lines 1-15 and col.7, lines 37-57).

It would have been obvious to one in the ordinary skill in the art at the time the invention was made to combine address change server having old to new address change capability and the ability to send the new address to the sender as taught by Nielsen with address change notification deputization service server described by Reilly to facilitate the sender in discovering the new address of a recipient that he/she is trying to reach from the old address and in turn making the address discovering process more robust for the user.

7. As per claims 2 & 11 Reilly-Nielsen disclosed the e-mail address change notification deputization system according to Claim 1, wherein said address change notification deputization service server is provided with an e-mail header analyzing means of extracting and analyzing the e-mail header from said transferred e-mail, and wherein said e-mail header analyzing means checks said path by analyzing the e-mail header of said e-mail (Nielsen, col.7, lines 26-35).

8. As per claims 3 & 12 The e-mail address change notification deputization system according to Claim 1, wherein a terminal of said client receives said e-mail from said second provider server, and the e-mail received by the terminal of said client has the

same contents as of the e-mail transferred to said address change notification deputization service server (Reilly, col.4, lines 44-62).

9. As per claims 6 & 15 Reilly-Nielsen disclosed the e-mail address change notification deputization system according to Claim 1, wherein said address change notification deputization service server has e-mail addresses of a predetermined one or a plurality of senders that send an e-mail to said client, and wherein the operation of making said notification is stopped when all the e-mails sent from the e-mail addresses of said senders have been confirmed to be received by said second provider server without passing through said first provider server (Reilly, col.6, lines 66-67 & col.7, lines 1-26).

10. As per claims 7 & 16 Reilly-Nielsen disclosed the e-mail address change notification deputization system according to Claim 1, wherein said address change notification deputization service server simultaneously sends a program for rewriting said first e-mail addresses of said client that is inscribed in an address book of the receivers of said notification to said second mail addresses at the time when carrying out the operation of making said notification (Reilly, col.9, lines 34-58).

11. As per claims 8 & 17 Reilly-Nielsen disclosed the e-mail address change notification deputization system according to Claim 1, wherein in the case that a sender of an e-mail to said client is an information distributor, said sender make a contract with the manager of said address change notification deputization service server such that said information distributor spontaneously switches said first e-mail addresses for said client to said second e-mail addresses in the case that said information distributor receives said notification from said address change notification deputization service server (Neilson, col.4, lines 59-67 & col.5, lines 1-21).

12. As per claims 9 & 18 Reilly-Nielsen disclosed the e-mail address change notification deputization system according to Claim 8, wherein a terminal of said information distributor is provided with a means of switching the addresses of said client to the second e-mail addresses in the case that said notification is received from the manager of said address change notification deputization service server who has made said contract (Neilson, col.6, lines 56-67 & col.7, lines 1-15).

13. As per claims 29, 30 & 31 Reilly-Nielsen disclosed a medium that holds a program for allowing a computer to function as the entirety of, or a part of, the first provider server in which the first e-mail address of the client is set, the second provider server in which the second e-mail address of said client is set and the address change notification deputization service server in the e-mail address change notification



deputization system according to Claim 1, wherein the medium can be processed by a computer (Reilly, col.4, lines 44-62).

***Response to Arguments***

14. Applicant's arguments filed 07/19/2006 have been fully considered but they are not persuasive.

15. Applicant argued that in Reilly is not capable of sending notice during the time period before the e-mail address has become invalid as described in amended claim language.

16. As to applicant arguments examiner has rejected the amended claim language under 112 second paragraph as being indefinite above on line 1 of this office action. Additionally Reilly discloses that e-mail sent to the old address is being automatically forwarded to the new address (col.2, lines 63-67 & col.3, lines 1-26) and figure 2. The fact that the e-mail was received at the first provider server (old provider) shows that the address was "valid" at first provider server. Because if the address was "not valid" then it would not have reached at the first provider server in the first place. Basically the first provider server (old provider) receives the e-mail and sends it automatically to the second provider server (new provider) where the e-mail address is also valid.

**Additionally, the fact that the e-mail is received at the old and new provider servers shows that it is "valid" on both locations, the only difference is that the old server provider is no longer the final destination of the e-mail.** Therefore the

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old server provider automatically sends the e-mail to the second provider server (new provider), which is designated as the final destination of the e-mail.

17. Applicant argued that Nielson does not disclose notifying that the e-mail address is changed "until the e-mial address set in the first provider server is invalid as said client's address".

18. As to applicants argument examiner has rejected the amended claim language under 112 second paragraph as being indefinite above on line 1 of this office action. Additionally in Nielson the process by which the address change server provides the new address to the sender of an e-mail who has sent an e-mail to the old address is based on analysis of the address of the old address which was indented to go in a different path I.E towards that old provider server and therefore based on the analysis the address change server sends a reply to the sender with the recipient's updated e-mail address. E-mail sent to an address for example, SAM@yahoo.com dictates the destination path of that message which is a server at Yahoo domain vs an e-mail sent to SAM@google.com address which is sent to a different destination path (col.4, lines 44-62 & col.6, lines 11-27).

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Asghar Bilgrami whose telephone number is 571-272-3907. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 571-272-3924. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
AB

  
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